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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/615,708	07/13/00	MIZUTANI	K Q60118

IM22/0723

SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLL
2100 PENNSYLVANIA AVENUE, N.W.
WASHINGTON DC 20037

EXAMINER
HAMILTON, C

ART UNIT	PAPER NUMBER
1752	

DATE MAILED: 07/23/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09-615,708

Applicant(s)

Mizutani et al

Examiner

C. Hamilton

Group Art Unit

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—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on 4-9-01 + 5-18-01

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 12, 14-22, 24 is/are pending in the application.

Of the above claim(s) 14-18, 20, 22, 24 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 12, 21 is/are rejected.

☒ Claim(s) 19 is/are objected to.

☒ Claim(s) 12, 14-22, 24 are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☒ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☒ Certified copies of the priority documents have been received in Application No. 08-997,393

☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 2

☐ Interview Summary, PTO-413

☒ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Skoultchi (3,575,925). The polymer compositions of Examples I, III, V and VI of Skoultchi anticipated the anti-reflective coating material composition of applicants wherein instant polymer formulas (XIII) and (VXIV) are considered. In each case, $n=0$ and $m=0$. For instant formula XIII, and Skoultchi VI A_1 is a substituted is naphthyl group (-naphthyl- $c(=O)$ -). For instant formula XIII and Skoultchi I A_1 is-phenyl- $c(=O)$ -. For formula for instant formula XIII and Skoultchi III, A_1 is-phenyl- $c(=O)$ -. For instant formula VXIV and Skoultchi V, A_2 is - $c(=O)$ -phenyl. For instant

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formula VXIV, A_2 is $-c(=O)$ -naphthyl. These polymer compositions are inherently useful as anti-reflective coating material.

Claims 12 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Mizutani et al (6,090,531).

The compositions of Mizutani et al anticipated the compositions of instant claim 12 and 24 wherein the polymers chosen as set forth in col. 3, lines 14-55 for A are A-9 or A-22. These polymers read on instant formula IX wherein $n=0$ and $M=1$ and $Z_2=OH$. The compositions of Mizutani et al anticipate the instant claim 12 composition wherein the polymer chosen as set forth in col. 3, lines 59-col. 4, lines 24, are B8, B16 or B17. Since only one choice, that of either Polymer A or B is made for each disclosed anti-reflective coating material, these compositions are held anticipatory. In re to the small choice of specific detailed species for each polymer.

Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Teuscher (3,943,108).

The polymer of Teuscher's Examples III-VII wherein (e) or (d) from the top of col. 7 are reacted to form polymeric compounds that are cast as solutions anticipate the instant compositions of claim 12 wherein formula IX is used and $X_1=H$, $n=0$, $m=0$, $X_2=H$.

Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Unruh et al (2,716,103).

Unruh et al's composition of Example 14 as amplified by the reaction scheme in col. 1-2 clearly anticipated the polymer composition of instant formula IX wherein X_2 and $X_1=H$, $n=0$, $m=0$. This composition is inherently useful as an anti-reflective coating.

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Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Unruh et al (2,716,097).

Unruh et al's composition wherein R¹ is represented by alpha or beta naphthyl with or without substitutions as set forth in col. 1-2 (especially noting col. 2, lines 57-59) anticipated the instant polymer composition wherein claim 12, polymer of formula IX is selected.

Newly submitted claim 24 (as now amended) directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: it relates to the original claims as a process of use of the product. The inventions are distinct if the product as claimed can be used in a materially different process (MPEP 806.05(h)). This is shown for the original claims by the process of imaging used by Unruh and the process of charge carrier transport used in Teuscher.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 24 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The examiner notes claim 19 should not have been made a choice for election because it is also improperly multiply dependent as it depends on claims 12 and 18 simultaneously.

Claim 19 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits.

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Claims 14-18, 20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in Paper No. 5, filed April 9, 2001.

Applicant's election with traverse of species A (claim 21) as supported by specification selection of working example 20 and request to search polymer and second component first in Paper No. 5 is acknowledged. The traversal is on the ground(s) that claims 14-20 would cover or read on claim 21. This is not found persuasive because claim 12 is the generic linking claim between species A, B and C. Only claim 21 has the second specified components as elected. Since the broad generic claim 12 is rejected all claims without the component are no longer linked to the elected species.

The requirement is still deemed proper and is therefore made FINAL.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 12 is objected to because of the following informalities: in line 16 of claim 12, "toms" should be "atoms". Appropriate correction is required.

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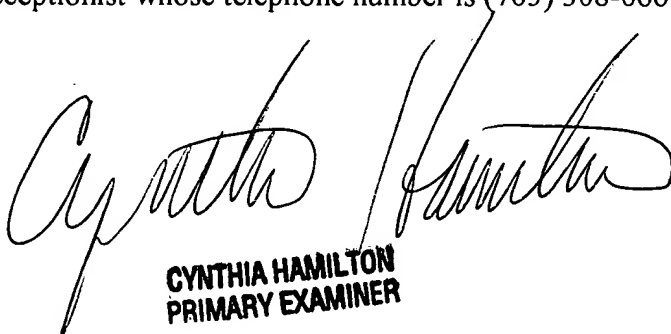
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Hamilton whose telephone number is (703) 308-3626. The examiner can normally be reached on Monday-Friday from 9:30 am EST to 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Janet Baxter, can be reached on (703) 308-2303. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3599 for After Final Responses or (703) 305-7718 for all other responses.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Hamilton:mv

July 20, 2001



**CYNTHIA HAMILTON
PRIMARY EXAMINER**